

REMARKS

Claims 1-9 are currently pending. Claim 1 is currently amended. Claims 10-28 are cancelled without prejudice. Applicants wish to thank the Examiner for the indication of allowable subject matter in claim 4. No new matter has been added.

Independent claim 1 is amended to more particularly point out that the first compartment houses the medical device, and the second compartment contains an anti-microbial agent.

No new matter has been added by these amendments.

Rejections under 35 U.S.C. § 102

Claims 1 and 5-9 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,996,450 to Askew ("Askew"). Claims 1-3 and 5-9 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,552,968 to Ladyjensky ("Ladyjensky"). Claims 1, 2 and 5-9 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,143,211 to Miczka ("Miczka"). These rejections should be withdrawn.

Independent claim 1 recites "a system for packaging a *medical device*" comprising a first compartment "housing the *medical device*" and a second compartment "containing an *anti-microbial agent*." None of Askew, Ladyjensky, or Miczka disclose a "medical device" or "anti-microbial agent." In rejecting claim 1 as anticipated by Askew, Ladyjensky, and Miczka, however, the Examiner stated that the devices in these references are "inherently capable" of containing medical devices and anti-microbial agents. (Office Action mailed 8/25/06 at 3-4).

To establish inherency, extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted). "The fact that a certain characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP § 2112 (citing *In re Rijkkaert*, 9 F.3d 1531 (Fed. Cir. 1993)) (emphasis in original). Furthermore, when relying on the theory of inherency as a basis for rejection, the MPEP requires that the Examiner "must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic

necessarily flows from the teachings of the applied prior art.” *Id.* (citing *Ex parte Levy*, 17 USPQ2d 1461 (Bd. Pat. App. & Inter. 1990) (emphasis in original)).

None of the references cited by the Examiner meet the standard of inherency. Moreover, the Examiner has not provided any basis in fact or technical reasoning that reasonably supports the determination that these references are inherently capable of containing medical devices and anti-microbial agents. In Askew, which recites a partitioned ice chest, nothing in the description discloses or suggests that containing a medical device and an anti-microbial agent is a necessary characteristic of the ice chest. Likewise, there is no disclosure or suggestion that containing a medical device and an anti-microbial agent is a necessary characteristic of the chemiluminescent lighting element of Ladyjensky, which is primarily described as a fishing lure. Finally, in Mizcka, which recites a multi-chamber container for mixing substances such as epoxy resin and hardener, the missing descriptive matter referring to a medical device and an anti-microbial agent is not necessarily present. Accordingly, “a system for packaging a *medical device*” comprising a first compartment “housing the *medical device*” and a second compartment “containing an *anti-microbial agent*” is not inherently disclosed by Askew, Ladyjensky, or Mizcka.

Thus, as Askew, Ladyjensky, and Mizcka fail to describe each and every element of claim 1, the rejections of claim 1 should be withdrawn. Moreover, as claims 2-3 and 5-9 depend from independent claim 1, the rejections of those claims should be withdrawn as well, for at least this reason.

CONCLUSION

It is believed claims 1-9 are in condition for allowance. Should the Examiner not agree with any of Applicant's positions or arguments herein, a telephonic or personal interview is respectfully requested to discuss and resolve any remaining issues.

A one-month extension fee in the amount of \$120 is believed due for this response. Please charge this fee, and any additional fee(s) that may be due, to Jones Day Account No. 503013.

Respectfully submitted,

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s/Brent P. Ray

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